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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,473	08/03/2001	Alex Ulrich	155696-0033	7208
1622	7590	08/11/2004	EXAMINER	
IRELL & MANELLA LLP 840 NEWPORT CENTER DRIVE SUITE 400 NEWPORT BEACH, CA 92660			THOMPSON, MICHAEL M	
			ART UNIT	PAPER NUMBER
			3763	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/922,473

Applicant(s)

URICH, ALEX

Examiner

Michael M. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: It is the Examiner's position that Applicant has evoked sixth paragraph, means-plus-function language to define Applicant's invention. Therefore the Examiner requires the Applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o) to explicitly state, with reference to the terms and phrases of the claim element, what structure, **materials**, and **acts** perform the function recited in the claim element. Please note that the MPEP clearly states, "Even if the disclosure implicitly sets forth the structure; materials, or acts corresponding to the means-(or step-) plus-function claim element in compliance with 35 U.S.C. 112, first and second paragraphs, the PTO may still require the applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o)...". (Also see **MPEP 2181** (Rev. 1, Feb.2000))

Appropriate correction is required.

### *Claim Objections*

2. Claims 16-18 and 20-24 are objected to because of the following informalities: It is the Examiner's position that Applicant has evoked sixth paragraph, means-plus-function language to define Applicant's invention. Therefore the Examiner has objected to the claims for the reasons set forth above in the objection to the specification.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 5, 7, 11, 12, 16, 20 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Easley (6,599,271). Easley teaches an input tube, a filter housing with filter, an input, and a flow restrictor wherein the filter is into the filter housing.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 8, 13, 17, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Easley ('271). Easley teaches all of the limitations of the claims except for explicitly reciting a flow restrictor that has a diameter between 0.1 to 1 millimeters. It is the Examiner's position that the device of Easley is an ophthalmic device and it would have been obvious to one of ordinary skill in the art, at the time of invention that the diameter of the flow restrictor and

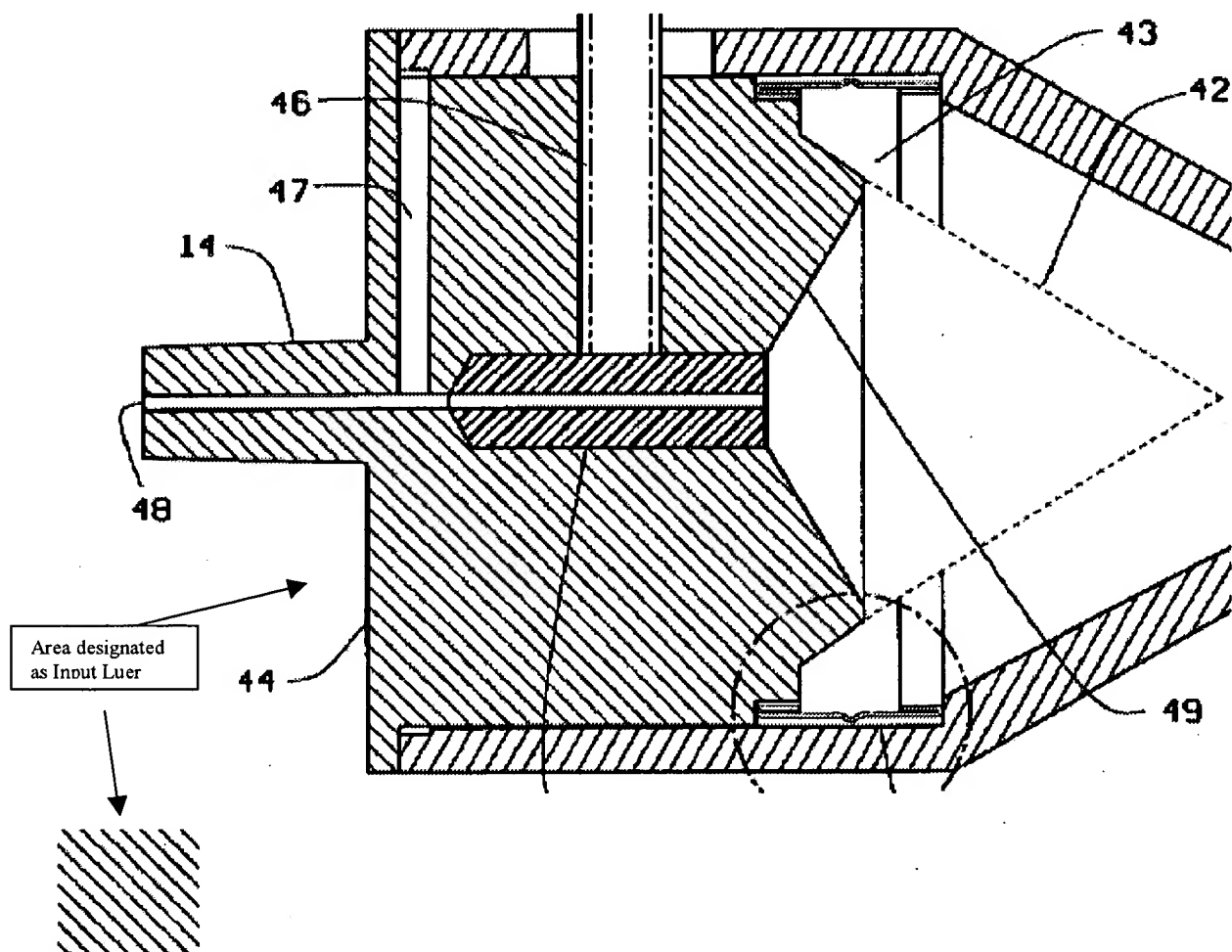
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potentially the flow tubing would be between 0.1 to 1 millimeters which is common in the art of eye surgical devices. Regardless, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have a flow restrictor similar to the size of the tubing being used for a surgical device of between 0.1 to 1 millimeters because Applicant has not disclosed that a flow restrictor with a diameter between 0.1 to 1 millimeters provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with a flow restrictor having a tubing diameter of the ophthalmic device as taught by Easley or a diameter of less than 0.1mm or slightly larger than 1 mm because in both instances the diameters are suitable for performing aspiration within the eye of a patient. Therefore, it would have been an obvious matter of design choice to modify Easley to obtain the invention as specified in the claims rejected supra.

7. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Easley in view of Beuchat. Easley teaches all of the limitations of the claims except for explicitly reciting luer fittings on the input and output tubing. Beuchat teaches luer type fittings for tubing. It would have been obvious to one of ordinary skill in the art, at the time of invention to have modified the device as taught by Easley with luer type fittings for connecting any tubing of the aspiration device for the well know purpose of providing a versatile method connectivity and allowing for the user to change portions of the device if they become defective or used.

*Response to Arguments*

8. Applicant's arguments filed 03/26/2004 have been fully considered but they are not persuasive. In addressing Applicant's arguments with respect to Easley, Applicant should note the Abstract which recites all of the structural limitations recited by Applicant such as a flow restrictor and input luer. A correct depiction of Figure 3 shows a filter (42 or 43) that is not more than twice the size of the input luer and is pressed into the input luer. Shown below.



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It is further the Examiner's position that a non linear relationship between fluid pressure and fluid flow rate is present in the Easley device. The mere fact that a flow restrictor and/or filter is within the pathway of the flow path provides a non linear relationship between the pressure and flow rate which is further affected by the control by the user. If Applicant disagrees then Applicant is directed to recite those structural features that provide the non linear relationship that are not recited in the independent claim. It is the Examiners position that the structural limitations have been met. In addressing obvious design choice relating to the flow restrictor, it is the Examiner's position that Claim 17 provides support for modifying the diameter of the restrictor. Lastly, the requirement to further address the means language relating to the material or acts is still outstanding and hasn't been completely addressed.

In conclusion, it is understood that Applicant has fully responded to all rejections and raised all errors with respect to the Examiner's rejection and since there is no further traversal beyond the above-mentioned issues it appears that Applicant has acquiesced to all other rejections of record and the instant Office Action has been made Final.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### Contacts

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Michael Thompson whose telephone number is (703) 305-1619. The Examiner can normally be reached on Monday through Friday from 9 am to 5 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Primary, Brian Casler, can be reached on (703) 308-3552. The official fax phone number for all submissions to the organization where this application or proceeding is assigned is (703) 872-9306.


Michael M. Thompson

Patent Examiner

MT



August 4, 2004



BRIAN L. CASLER  
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